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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) MSDI-245/PC819.00	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 19, 2008</u> Signature <u><i>Douglas A. Collier</i></u> Typed or printed name <u>Douglas A. Collier</u>		Application Number <u>10/680,358</u>	Filed <u>October 7, 2003</u>
		First Named Inventor <u>Frank J. Schwab et al.</u>	
		Art Unit <u>3733</u>	Examiner <u>Nicholas W. Woodall</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43,556</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u><i>Douglas A. Collier</i></u> Signature <u>Douglas A. Collier</u> Typed or printed name <u>(317) 238-6333</u> Telephone number <u>November 19, 2008</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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NOV 19 2008

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:	)	Before the Examiner:
Frank J. Schwab et al.	)	Nicholas W. Woodall
	)	
Application Serial No. 10/680,358	)	Group Art Unit:
	)	3733
Filed: October 7, 2003	)	
	)	Attorney Ref. No.:
INSERTION DEVICE AND TECHNIQUES	)	MSDI-245/PC819.00
FOR ORTHOPAEDIC IMPLANTS	)	
	)	November 19, 2008

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated August 6, 2008, and Advisory Action mailed October 24, 2008, please consider the following. No extensions of time are believed due. A Notice of Appeal, and form PTO/SB/33 Pre-Appeal Brief Request for Review is submitted herewith along with the fee under 37 CFR 41.20(b)(1). Please provide any extensions of time necessary and charge any additional fees due, or credit any overpayment, to Deposit Account 12-2424, but not including the payment if issue fees.

I hereby certify that this correspondence is  
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November 19, 2008  
(Date of Transmission)

Douglas A. Collier  
Name of Registered Representative

*Douglas A. Collier*  
Signature

November 19, 2008  
Date of Signature

Response to Final Office Action  
Application Serial No. 10/680,358  
Atty Docket No. MSDI-245/PC819.00  
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**REMARKS**

In the Final Office Action mailed August 20, 2008, and Advisory Action mailed November 10, 2008, claims 1, 3-19, 22-27, 29-40, 49-51 and 53-57 were pending. Claims 1, 3-4, 9, 11-14, 16-19, 22, 23, 26, 27, 29, 30, 32, 37-40 and 49-51 were rejected, and claims 5-8, 10, 15, 24, 25, 31, 33-36 and 53-57 were objected to but indicated to be allowable. A request to reconsider the final rejection of the rejected claims was made in a response filed on October 20, 2008. This request is being submitted since it is believed that a prima facie case for rejecting each of currently pending and finally rejected claims has not been established.

Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,677,798 to Phillips. Arguments traversing this rejection are of record in the 10/20/08 response on page 12, second paragraph. The Final Office Action asserts that elements (a) and (b) are guide members extending distally from frame 44 in Figure 5. However, the flange of element (a) and the flange of element (b) do not extend along a side of the respective element (a) and element (b) that extends from the proximal end to the distal end of the respective element (a) and (b). Rather, the flange extends transversely to the proximal and distal directions. Since claim 1 recites features that each of the guide members includes "opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides", claim 1 is not anticipated by Phillips. Claim 9 depends from claim 1 and distinguishes Phillips at least for the reasons claim 1 does.

Claims 38, 39, and 49-51 stand rejected under 35 USC §102(b) as anticipated by DE 297 03 850. Arguments traversing this rejection are found in the 10/20/08 response from page 12, third paragraph, through page 13, second paragraph. DE 297 03 850, discloses members that include facing surfaces that are concavely curved from one side of the member to the other side of the member, and thus are not generally parallel. Since claim 38 recites, among other features, "said guide surfaces being generally parallel with one another", neither claim 38 nor claim 39 depending from claim 38 are anticipated by DE 297 03 850.

Claim 49 recites, among other features, "said first and second guide members each including: opposite first and second sides extending between a proximal end and a distal end; a

guide surface extending from said proximal to said distal end between said first and second sides and being oriented toward the guide surface of the other of said first and second guide members; and a width between said first and second sides, said width being greater than a width of an implant to be positioned along said guide surfaces.” The Office Action does not indicate how DE 297 03 850 discloses that the width between the sides of the facing surfaces of the members is greater than a width of an implant to be positioned along the facing surfaces. Therefore, a prima facie case for rejecting claim 49 as anticipated by DE 297 03 850 has not been established.

Claim 50 recites, among other features, “wherein each of said first and second guide members include a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members.” The Office Action does not indicate how DE 297 03 850 is considered to disclose the only one guide flange of each of the guide members as recited in claim 50. Therefore, a prima facie case for rejecting claim 50 or claim 51 depending from claim 50 is not established.

Claims 1, 9, 11-14, 16-19, 26, 29, 30, 32, 37-40 and 49-51 stand rejected under 35 USC §102(e) as anticipated by U.S. Patent No. 6,599,294 to Fuss. Arguments traversing these rejections are of record in the 10/20/08 response from page 13, third paragraph to page 16, second paragraph. Fuss discloses an instrument 1 with two arms 3, 4 which are substantially identical in construction. See col. 4, lines 40-44. Each arm includes a flat guide body 5, and the two guide bodies 5 are U-shaped in cross-section and comprise a mutually opposing flat guide surface 10 laterally delimited by side walls 11 which extend the entire length of guide surface 10 and project in the direction of the other guide body. The two guide bodies 5 form between them a guideway delimited at the top and underside by the two guide surfaces 10 and at the sides by the side walls 11, where each guide body 5 includes a pair of side walls 11. See col. 4, lines 58-67 and Figures 1-3.

In contrast, claim 1 recites that each guide member includes “opposite first and second sides extending between a proximal end and a distal end; a guide surface extending from said proximal to said distal end between said first and second sides; and a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide

surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members.” Since Fuss fails to disclose the guide member with only one guide flange extending therealong as recited in claim 1, it cannot anticipate claim 1. Claims 9, 12-14 and 16-18 depend directly or indirectly from claim 1 and distinguish Fuss at least for the reasons claim 1 does and for other reasons provided in the 10/20/08 response.

Claims 11 and 19 also distinguish Fuss for the reasons provided above with respect to claim 1. Claims 26, 29, 30, 32, and 37 depend directly or indirectly from claim 19 and distinguish Fuss at least for the reasons claim 19 does and for other reasons. For example, Fuss discloses that arms 3, 4 are pivotally coupled at joint 7, and when guide bodies 5 are moved relative to one another, guide bodies 5 move about joint 7 in non-parallel relation. Therefore, Fuss cannot anticipate claim 37.

Claim 38 recites “a distal portion including a first guide member and a second guide member extending along said first guide member, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members....” Furthermore, claim 38 recites “a proximal portion including a frame coupled to said first and second guide members, said frame being structured to move said first and second guide members toward and away from one another with said guide surfaces remaining generally parallel....” Fuss discloses that arms 3, 4 are pivotally coupled at joint 7, and when guide bodies 5 are moved relative to one another, guide bodies 5 move about joint 7 in non-parallel relation. Therefore, Fuss cannot anticipate claim 38 or claims 39 and 40 depending from claim 38.

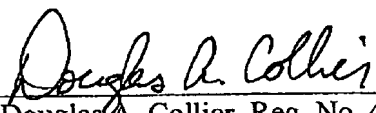
Claim 49 recites “a distal portion including a first guide member extending distally from said first arm and a second guide member extending distally from said second arm, said first and second guide members being movable toward and away from one another by moving said first arm relative to said second arm ....” As discussed above, Fuss discloses arms 3, 4 secured to one another about a pivot joint 7, and guide bodies 5 are moved by moving arms 3, 4 together about pivot joint 7. Therefore, Fuss does not anticipate claim 49.

Claim 50 recites "wherein each of said first and second guide members include a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members." As discussed above with respect to claim 1, Fuss fails to disclose that guide bodies 5 include only one guide flange and therefore cannot anticipate claim 50. Claim 51 depends from claim 50 and distinguishes Fuss at least for the reasons claim 50 does, and also for the reasons claim 39 does as discussed above.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 297 03 850 in view of U.S. Patent App. Pub. No. 2004/0024291 to Zinkel. Claim 27 recites "a distal portion including a first guide member extending distally from said movable arm and a second guide member extending distally from said stationary arm, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members, said first and second guide members being movable toward and away from one another by moving said movable arm relative to said stationary arm while maintaining said guide surfaces in parallel relation...." As discussed above, DE 297 03 850 discloses members with facing surfaces that are concavely curved from one side to the other side, and thus the surfaces are not in parallel relation. Furthermore, Zinkel teaches non-parallel movement of facing surfaces of the retractor disclosed therein. Therefore, a prima face case for rejecting claim 27 has not been established.

Claims 3, 4, 22 and 23 stand rejected as being unpatentable over Fuss in view of U.S. Patent No. 5,431,658 to Moskovich. These claims are allowable at least for the reasons their respective base claims are allowable. Reconsideration of the finally rejected claims is respectfully requested.

Respectfully submitted,

By:   
Douglas A. Collier, Reg. No. 43,556  
Krieg DeVault LLP  
One Indiana Square, Suite 2800  
Indianapolis, Indiana 46204-2079  
(317) 238-6333 voice

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Atty Docket No. MSDI-245/PC819.00  
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